

**REMARKS**

Claims 2, 3, 4, 5, 7, 8, 11, 16 and 17 have been amended to recite at least one carboxyl group instead of at least one substituent having an alkali-dissociating proton, and claims 6 and 15 have been canceled accordingly.

Entry of the above amendment is respectfully requested.

**Information Disclosure Statement filed March 11, 2005**

Applicants note that the Examiner has not yet returned an initialed copy of the PTO/SB/08 form filed with the Information Disclosure Statement on March 11, 2005. Applicants respectfully request that the Examiner consider the disclosed information and return an initialed PTO/SB/08 form with the next communication from the PTO.

**Rejection under 35 U.S.C. 112, First Paragraph**

On page 2 of the Office Action, in paragraph 6, claims 2-11, 13-20 are rejected under 35 U.S.C. 112, first paragraph.

**The Examiner's Position**

The Examiner's position is basically that the specification, while being enabling for a compound having a structure represented by general formula (1) wherein X<sup>-</sup> is selected from the group consisting of a phenolic hydroxyl group, a carboxyl group, a mercapto group, a phosphonic acid group, a phosphoric acid group, a sulfonamide group, a substituted sulfonamide

based group, a sulfonic acid group, a sulfinic acid group,  $-\text{C}(\text{CF}_3)_2\text{OH}$ , and  $-\text{COCH}_2\text{COCF}_3$ , does not reasonably provide enablement for an alkali-dissociating proton.

### **Applicants' Response**

While it is submitted that the claims do not need to be limited only to specifically disclosed examples, in order to expedite allowance Applicants have amended the claims to recite one of the groups identified by the Examiner such that the invention is clearly enabled by the specification.

Accordingly, Applicants submit that the present claims satisfy the requirements of 35 U.S.C. 112, first paragraph, and withdrawal of this rejection is respectfully requested.

### **Obviousness Rejection**

On page 3 of the Office Action, in paragraph 8, claims 2-10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyake et al. (EP 1211065 A2) in view of Kitatani et al. (JP 11-119421).

### **The Examiner's Position**

The Examiner's position is that the planographic printing plate precursor of Miyake et al. comprises a recording layer containing a water-insoluble and alkali-soluble resin, an infrared absorbent and an organic quaternary ammonium salt, wherein the infrared absorbent can be any material as long as it generates heat upon absorbing infrared radiation and preferably is an infrared absorbing dye. The Examiner considers that it would have been obvious to incorporate an infrared absorbing dye, such as the infrared absorbing cyanine dye of Kitatani et al., into

Miyake et al. with a reasonable expectation of obtaining high sensitivity. In this regard, the Examiner notes that the infrared absorbing cyanine dye of Kitatani et al. comprises an n-valent anion and that examples of dyes include those of Formulae 6, 7 and 8, all of which comprise an aryl anion substituted with a hydroxyl group and at least one SO<sub>3</sub> group. The Examiner indicates that these infrared absorbing cyanine dyes meet the structural limitations for the onium salt of the present application, and that when more than one infrared absorbing dye is used in the material of Miyake et al., the limitation for a light-heat converting agent is met as well.

**Applicants' Response**

In response to this rejection, Applicants note initially that the claims have been amended to recite at least one carboxyl group as set forth above.

In contrast, Applicants submit that neither Miyake et al. (EP 1211065A2) nor Kitatani et al. (JP 11-119421) has a counter anion containing at least one carboxyl group, and there is also no suggestion regarding such a counter anion.

Thus, Applicants submit that the present invention is not obvious over the combination of Miyake and Kitatani.

Further, the effects of the present invention are to exhibit both of “high sensitivity” and “large difference between solubilities at an exposed area and an unexposed area (solubility discrimination)”.

In contrast, the effects of the lithographic printing plate material disclosed in Kitatani are to exhibit “high sensitivity” and “excellent printability” (see paragraph [0005]), and this reference neither teaches nor suggests improving both of “high sensitivity” and “solubility

discrimination” by using a specific compound (infrared absorbent) having a counter anion containing at least one carboxyl group.

Therefore, Applicants submit that there is no motivation to combine Miyake and Kitatani to arrive at the present invention.

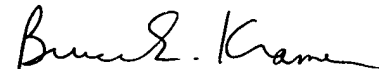
In view of the above, Applicants submit that the present invention is not obvious over Miyake in view of Kitatani. Accordingly, withdrawal of this rejection is respectfully requested.

### **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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**23373**

CUSTOMER NUMBER

Date: March 8, 2006